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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,159	03/19/2001	Shuwu Wu	06975-099001	9046
26171	7590	12/02/2005	EXAMINER	
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			NAWAZ, ASAD M	
			ART UNIT	PAPER NUMBER
			2155	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/810,159

Applicant(s)

WU ET AL.

Examiner

Asad M. Nawaz

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 40 and 26-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25, 37-39 and 41-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the amendment filed on 6/15/05. Claims 26-36 and 40 have been withdrawn and/or canceled. Claims 1-25 and 37-39 have been amended. Claims 41-44 have been newly added. Accordingly, claims 1-25, 37-39, and 41-44 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-25, 37-39, and 41-44 are rejected under 35 U.S.C. 102(e) as being anticipated by Cook et al (USPN: 6879665) hereinafter referred to as Cook.

As to claim 1, Cook teaches a communications method comprising: establishing a text instant messaging communication session between a sender and a recipient through an instant messaging host; (col 2, lines 31-46)

facilitating a text instant message to be sent from the sender to the recipient during the session, the text instant message including message text inputted by the sender; (col 2, lines 31-46)

enabling presentation of a first text instant messaging graphical user interface to the recipient that includes a display of the message text and an icon, the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message between the sender and the recipient; and (Figs 5A-8; col 2, lines 31-46; col 7, lines 5-28)

enabling manipulation by the recipient of the icon to invoke voice communication between the sender and the recipient through the instant messaging host. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 2, Cook teaches the method of claim 1 further comprising receiving and authenticating the text instant message from the sender at the instant messaging host (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system).

As to claim 3, Cook teaches the method of claim 2 wherein authenticating the text instant message comprises identifying a screen name associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 4, Cook teaches the method of claim 2 wherein authenticating the text instant message comprises identifying an IP address associated with at least one of

the sender and the recipient (Fig 5; col 3, lines 47-60; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system. A system that employs the TCP/IP suite, such as the one disclosed by Cook, always check for sender/receiver or sending/destination address.).

As to claim 5, Cook teaches the method of claim 1 further comprising determining voice communication capabilities of the recipient at the instant messaging host.(col 6, lines 42-60)

As to claim 6, Cook teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying hardware associated with the recipient. (col 6, lines 42-60)

As to claim 7, Cook teaches the method of claim 5 wherein determining voice communication capabilities comprises identifying software associated with the recipient. (col 6, lines 42-60)

As to claim 8, Cook teaches the method of claim 5 further comprising reporting the voice communication capabilities of the recipient to the sender. (col 6, lines 42-60)

As to claim 9, Cook teaches the method of claim 8 further comprising presenting a second text instant messaging interface to the sender that varies according to the capabilities of the recipient. (col 6, lines 42-60)

As to claim 10, Cook teaches the method of claim 1 further comprising receiving, at the instant messaging host, a request to establish voice communication (col 2,lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 11, Cook teaches the method of claim 10 wherein the request is from the sender(col 2,lines 31-46; col 6, lines 26-41; col 7, lines 5-28).

As to claim 11, Cook teaches the method of claim 10 wherein the request is from the recipient(col 2,lines 31-46; col 6, lines 26-41; col 7, lines 5-28).

As to claim 13, Cook teaches the method of claim 10 further comprising authenticating the request (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 14, Cook teaches the method of claim 11 wherein authenticating the request comprises identifying a screen name associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 15, Cook teaches the method of claim 11 wherein authenticating the request comprises identifying an IP address associated with at least one of the sender and the recipient. (Fig 5; col 6, lines 26-41; the authentication system is inherent within any email/voicemail/text messaging system)

As to claim 16, Cook teaches the method of claim 1 wherein enabling voice communication comprises establishing a generic signaling interface channel, a control channel, and an audio channel between the sender and the recipient.(col 3, lines 46-60)

As to claim 18, Cook teaches the method of claim 16 wherein the control channel comprises a TCP/IP socket. (col 3, lines 46-60)

As to claim 20, Cook teaches the method of claim 16 wherein the audio channel comprises a TCP channel. (col 3, lines 46-60)

Claims 21-22 are rejected under the same rationale as the above-mentioned claims.

As to claim 23, Cook teaches the computer program of claim 22 wherein the computer readable medium is a disc. (col 5, lines 11-39)

As to claim 24, Cook teaches the computer program of claim 22 wherein the computer readable medium is a client device. (col 5, lines 11-39)

As to claim 25, Cook teaches the computer program of claim 22 wherein the computer readable medium is a host device. (col 5, lines 11-39)

As to claim 37, Cook teaches the method of claim 1, wherein enabling manipulation of icon by the recipient to invoke voice communication comprises enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 38, Cook teaches the apparatus of claim 21, wherein the instant messaging host is configured to enable manipulation of the icon by the recipient to invoke voice communication by enabling manipulation by the recipient to invoke voice communication in response to delivery of the text instant message to the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 39, Cook teaches the computer program of claim 22, wherein the instructions for enabling manipulation of the icon by the recipient to invoke voice communication include instructions for enabling manipulation by the recipient to invoke

voice communication in response to delivery of the text instant message to the recipient.  
(col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

As to claim 41, Cook teaches the communications method of claim 1, wherein the presentation of the first text instant messaging graphical user interface being conditioned on communication of the text instant message comprises not presenting the first text instant messaging graphical user interface if the text instant message is not received by the recipient. (col 2, lines 31-46; col 6, lines 26-41; col 7, lines 5-28)

Claims 42-44 are rejected under the same rationale as the above-mentioned claims.

### ***Conclusion***

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of




the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asad M. Nawaz whose telephone number is (571) 272-3988. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached on (571) 272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
AMN

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER